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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,031	09/08/2004	Ian Alastair Kirk	200653 (8830-292)	8779

23973 7590 07/07/2005

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EXAMINER
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DANG, HOANG C

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/507,031	<b>Applicant(s)</b> KIRK ET AL.	
	<b>Examiner</b> Hoang Dang	<b>Art Unit</b> 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-20 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/08/2004</u> . | 6) <input type="checkbox"/> Other: ____  |

*HL*

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-4, 10, 12, 14, 15, 17-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bailey et al (US 6,098,717) (see “slotted expandable centralizer” 18 which has “slots” 26).

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3. Claims 1, 2, 4, 10, 12-15 and 17-20 are rejected under 35 U.S.C. 102(e) as clearly anticipated by Ducasse et al (US 6,789,622).

The claimed structure reads exactly on the reference's structure when members (150) and (152a,152b) of Ducasse et al are respectively considered as "slotted expandable centralizer" and "slots" as recited.

4. Claims 1, 2, 10, 11, 12, 14 and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Buytaert (US 2002/0112853).

The claimed structure reads exactly on the reference's structure when members 8, 16 and (spaces or slots defined between blades 16) of Buytaert are considered as "slotted expandable centralizer", "blades" and "slots" as recited. It noted that centralizer 8 of Buytaert is movable from a non-expanded configuration in Figure 1 to an expanded configuration in Figure 2.

5. Claims 1-3, 5-8, 10-12, 14, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Royer (US 5,785,125).

The claimed structure reads exactly on the reference's structure when members (44,46,48,50,52), (the spaces or slots defined between adjacent spring members 48-52) and (48-52) are respectively considered as (slotted expandable centralizer", "slots" and "blades" as recited. It noted that centralizer 12 of Royer is movable from a non-expanded configuration in Figure 2 to an expanded configuration in Figure 1.

6. Claims 1-4, 10, 12, 14, 15 and 17 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Lauritzen (US 6,662,876).

The claimed structure reads exactly on the reference's structure when members (420a-c and 520a-c) are considered as the "slotted expandable centralizer" as recited. As for claim 4,

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members 420a-c and 520a-c of Lauritzen is capable of receiving an expandable tubular and capable of being deformed radially with the expandable tubular upon expansion of the tubular. It is noted the claim does not required the "tubular".

7. Claims 1, 2, 4-8, 10-12, 14, 15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Simpson et al (US 6,899,181).

The claimed structure reads exactly on the reference's structure when members (500), (504) and (502) of Simpson et al are respectively considered as "slotted expandable centralizer", "slots" and "blades" as recited. As for claim 4, member 500 of Simpson et al is capable of receiving an expandable tubular and capable of being deformed radially with the expandable tubular upon expansion of the tubular. It is noted that the claim is not require the "tubular".

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bailey et al '717 or Lauritzen '876 in view of Metcalfe (US 6,065,500)

Bailey et al or Lauritzen discloses the invention as claimed except that the slots of adjacent rows are not disclosed as being overlapped. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the slots of Lauritzen

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overlapped as claimed in order to enhance its expandability in view of the teaching of Metcalfe (see slots 20 and column 1, lines 26-40).

*Allowable Subject Matter*

10. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Specification*

11. The disclosure is objected to because of the following informalities: Page 1, line 4, the word "application" should not be capitalized. Page 9, the last sentence should be ended with a period.

Appropriate correction is required.

*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

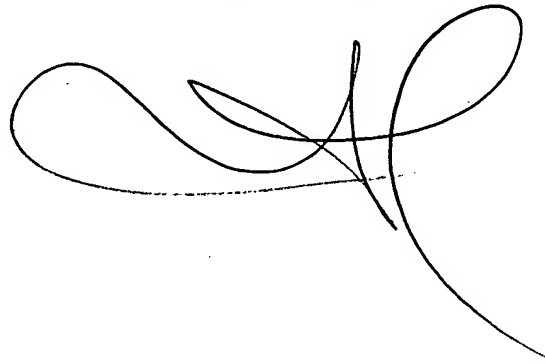
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Dang whose telephone number is 571-272-7028. The examiner can normally be reached on 9:15-5:45 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoang Dang  
Primary Examiner  
Art Unit 3672

A handwritten signature in black ink, consisting of a large loop on the left, a series of overlapping loops in the center, and a long, sweeping tail that curves downwards and to the right.